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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,321	08/21/2000	Michael C. Chen	1844030102CIBT- P01 - 513	9007
7590 12/03/2003			EXAMINER	
BARTON E. SHOWALTER, ESQ. BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			GEREZGIHER, YEMANE M	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 12/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/643,321

Applicant(s)

CHEN ET AL.

Examiner

Yemane M Gerezgiher

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This application has been examined. Claims 1-32 are pending.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28 and 29, recite "the step of establishing a communication channel between the first station and a third station ..." (claim 28, claim line 3-4 and claim 29, lines 5-7). Both claims 28 and 29 lack antecedent basis. A "... step of establishing a communication channel between the first station and a second station ...", has been previously defined in claim 25, but No "...step of establishing a communication channel between the first station and a third station ..." has been previously defined in a claim. Therefore it is not clear what the inventive entity meant to encompass by making use of "...establishing a communication channel between the first station and a third station ..." as recited in claims 28 and 29.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 and 12-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reese (U.S. Patent Number 6,374,237) in view of Engbersen et al (U.S. Patent Number 6,341,304) hereinafter referred to as Engbersen and further in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

Reese disclosed a method and system for requesting and receiving information from a remote server connected to a database. See Abstract. Reese showed a client at a station requesting for information from a the server connected to the database based on a user profile of the user and where the server was retrieving information that substantially matched with the user profile provided by the user using a user interface (see Fig.6, col.5, line 43 through col. 6, line 67). Reese disclosed a client at a first station establishing a connection with the server and sending personal information to the server where the server was connected with the database and retrieving and identifying information based on the users interest categories (claims 30-32) and sending and storing (claims 7, 9 and 24-29) the information at the station providing the client with best matched information from the database storing information in a pre-determined based on broad categories (claim 5). See col.3, lines 24-55. Reese disclosed the information been advertisements of different types and where the advertisement could example stock quotation information based on the clients provided personal interest (claims 12-14). See col. 4, lines 2-21 and col.1, lines 41 through col. 2, line 3. Reese disclosed a code module for gathering a user profile (claims 2, 6 and 22), related to the demographics of the user. See Figs. 4, 6 and 9, col.4, lines 37-54 and

Patent claims 6 and 14. Reese substantially disclosed the invention as claimed, however, failed to expressly teach a terminal/station having a controller determining available bandwidth between the server and the station and receiving information at the station based on the available bandwidth, or a station having a playback module for playing information stored at the station.

An artisan working with Reese's system at the time the invention was made, would have been motivated to look for arts that may have allowed a specific teaching in determining available bandwidth before requesting to receive/send data from a device to another device. In these arts, Engbersen disclosed determination of bandwidth available when requests for accessing (uploading or downloading) data item were made by network terminals by monitoring the bandwidth to receive data from a source (server or database) (claim 3 and 16), and determining whether information was successfully downloaded and if downloading was interrupted or aborted because of insufficient bandwidth, a request was added for resending (retry to send) the information to a client terminal (claim 4, 18 and 19). See abstract, Figs. 3 and 4, and Column 3, line 65 through Column 4, line 52. However, Engbersen did not specifically mention a station/device having a playback module for playing information stored at memory or storage of the station/device.

Examiner takes Official Notice (see MPEP § 2144.03) that "a playback module for playing information stored at a station" in a computer network communication environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to

MPEP § 2144.03. However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Engbersen related to determination of available bandwidth and have modified Reese related to establishing a voice connection between devices, so that uploading information from a remoter server to a client terminal could have been deferred or carried out based on the determined available bandwidth. Further it would have been obvious to take the commonly implemented playback module in a device or station and have modified the combined teachings of Engbersen and Sassin by integrating a playback module in order to play audible information stored in a station.

5. Claims 1-6, 11, 15, 16, 18-25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sassin et al (U.S. Patent Number 6,249,576) hereinafter referred to as Sassin in view of Engbersen et al (U.S. Patent Number 6,341,304) hereinafter referred to as Engbersen and further in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

Sassin disclosed a system and method providing directory information comprising a database and a server associated with the database and where the server was configured to transmit information based on a search request command signal and a first device "initiating a voice conversation" with a second device. See abstract. Sassin disclosed establishing a communication channel between a first device and a second device (claim 25) or a server associated with the device (a station), the device having a graphic user interface for a client of the telephone directory information system where the station/device was a telephonic (claim 11) device having a storage medium and a memory manager managing allocation, de-allocation, sharing and/or use of memory (claims 20, 21 and 24) and where the device could be integrated with a computer device and where the user interface was used to collect information from the user (claims 2, 22 and 30) in order to perform a search request from the server associated with the database (claims 5 and 6). See Figs.1-7, Column 1, line 66 through Column 3, line 60, Column 5, line 12 through Column 6, line 26, and Column 9, lines 5-46. However, Sassin did not expressly teach a device (a station) having a controller determining available bandwidth between the server and the station and receiving information at the station based on the available bandwidth, or a station having a

playback module for playing information stored at the station. However for a device to have a playback module for playing back stored information was well known in the art at the time the applicant's invention was made. See the Official Notice enclosed above.

An artisan aware of Sassin's invention would have been motivated to look for arts that may have allowed a specific teaching in determining available bandwidth before requesting to receive or send data from a device to another device. In these arts, Engbersen disclosed determination of bandwidth available when requests for accessing (uploading or downloading) data item were made by network terminals by monitoring the bandwidth to receive data from a source (server or database) (claim 3 and 16), and determining whether information was successfully downloaded and if downloading was interrupted or aborted because of insufficient bandwidth, a request was added for resending (retry to send) the information to a client terminal (claim 4, 18 and 19). See abstract, Figs. 3 and 4, and Column 3, line 65 through Column 4, line 52. However, Engbersen did not specifically mention a station/device having a playback module for playing information stored at memory or storage of the station/device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Engbersen related to determination of available bandwidth and have modified Sassin related to establishing a voice connection between devices, so that uploading information from a remoter server to a client terminal could have been deferred or carried out based on the determined available bandwidth. Further it would have been obvious to take the commonly implemented playback module in a device or station and have modified the combined



teachings of Engbersen and Sassin by integrating a playback module in order to play audible information stored in a station.

6. Claims 1, 3, 11, 15, 16, 18- 20, 22, and 25- 29 are rejected under 35 U.S.C. 103(a) as being un patentable over Jawahar et al (U.S. Patent Number 6,256,620) hereinafter referred to as Jawahar in view of Engbersen et al (U.S. Patent Number 6,341,304) hereinafter referred to as Engbersen and further in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

Jawahar disclosed a method apparatus for monitoring information access where therein a server associated with a database storing information where there is information module inherently disclosed and a station/device initiating a voice communication with another station/device where therein a storage and a memory manager at the first storage storing information (claims 20 and 21). Jawahar stated that a first device been a telephonic device (claim 11) having a user interface interacting with the device and storage comprising modules connected to the packet switched telephonic network establishing a voice communication with another station or the server. See Figs. 1 and 2, and col.5, line 35 through col.7, line 14. "Receiving information at the station occurring before or after sep of establishing a communication channel between the stations" (claims 9 and 25-29) was inherently disclosed since the server was connected to the station through a dedicated communication line. See col. 8, lines 6-8. However, Jawahar did not teach a playback module for playing information

received at a station and a flow control for determining available bandwidth to receive information at the station.

An artisan aware of Jawahar's invention would have been motivated to look for arts that may have allowed a specific teaching in determining available bandwidth before requesting to receive or send data from a device to another device. In these arts, Engbersen disclosed determination of bandwidth available when requests for accessing (uploading or downloading) data item were made by network terminals by monitoring the bandwidth to receive data from a source (server or database) (claim 3 and 16), and determining whether information was successfully downloaded and if downloading was interrupted or aborted because of insufficient bandwidth, a request was added for resending (retry to send) the information to a client terminal (claim 4, 18 and 19). See abstract, Figs. 3 and 4, and Column 3, line 65 through Column 4, line 52. However, Engbersen did not specifically mention a station/device having a playback module for playing information stored at memory or storage of the station/device. However, for a device to have a playback module for playing back stored information was well known in the art at the time the applicant's invention was made. See the Official Notice enclosed above.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Engbersen related to determination of available bandwidth and have modified Jawahar related to establishing a voice connection between devices, so that uploading information from a remoter server to a client terminal could have been deferred or carried out based on the

determined available bandwidth. Further it would have been obvious to take the commonly implemented playback module in a device or station and have modified the combined teachings of Engbersen and Sassin by integrating a playback module in order to play audible information stored in a station.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

- a. Hoyle, Martin David (U.S. Patent Number 6628314) Entitled: *Computer interface method and apparatus with targeted advertising*, disclosed an apparatus with targeted banner advertising.
- b. Himmel, Maria Azua et al (U.S. Patent Number 6,321,256) Entitled: *Method and apparatus for controlling client access to documents*, disclosed detecting, storing and retrieving information.
- c. Mueller, Hans-Peter et al. (U.S. Patent Number 6,009,398) Entitled: *Calendar system with direct and telephony networked voice control interface*, disclosed speech based interaction through a telecommunications network such as a telephone or via the World Wide Web.
- d. Hanson, Bruce Lowell et al. (U.S. Patent Number 5,974,398) Entitled: *Method and apparatus enabling valuation of user access of advertising carried by interactive information and entertainment services*, disclosed advertising related

operations where therein advertisers bid to advertise their products based on targeted user's user profile.

e. Shachar, Yuval (U.S. Patent Number 5,923,736) Entitled: *Hypertext markup language based telephone apparatus*, disclosed a telephone device including a display screen, input device, user interface, data communication interface, a memory storage, a processor and modem.

f. Nakanishi, Hiromi et al (U.S. Patent Number 4,722,078) Entitled: *Disc player*, disclosed a playback module.

g. Petty, Douglas et al (U.S. Patent Number 6,337,858) Entitled: *Method and apparatus for originating voice calls from a data network*, disclosed a voice communication between stations based on a computer controlled telephonic system where the communication was voice over Internet or PSTN voice connections.

h. Speicher, Gregory J (U.S. Patent Number 5,996,006) Entitled: *Internet-audiotext electronic advertising system with enhanced matching and notification*, disclosed electronic advertising system.

#### FOREIGN PATENT DOCUMENT

i. ALI, et al (EP 1047251 A1) Entitled: *A Retrieval of voice messages deleted from the voice message memory in a voice messaging system such as a telephone answering device*, disclosed retrieval and playback of a voice messaging system such as a phone answering station.

8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Yemane Gerezgiher whose telephone number is 703-305-4874. The examiner can normally be reached on Monday- Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, David A. Wiley, can be reached at 703-308-5221.

Yemane Gerezgiher  
AU 2142

MARC D. THOMPSON  
*MARC THOMPSON*  
PRIMARY EXAMINER

Monday, November 24, 2003